

Image
DAC
2876

520.40381X00



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Toshio ASANO et al.
Serial No.: 09/889,920
Filed: July 25, 2001
For: **NON-DESTRUCTIVE INSPECTION METHOD AND
APPARATUS THEREFOR**
Group: 2876
Examiner: Harold I. Pitts

**PETITION UNDER 37 CFR 1.181 FOR COMPLETE OFFICE ACTION
AND RESTARTING OF PERIOD FOR RESPONSE**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

February 2, 2004

Sir:

The Office Action (another unnumbered paper) dated on December 29, 2003, issued in connection with the above-identified application is acknowledged.

However, Applicants respectfully submit that the Office Action (an unnumbered paper) of December 29, 2003 is incomplete for the reasons discussed below.

Therefore, Applicants respectfully request that a decision on this petition be issued before the due date of March 29, 2004, for filing a response set in the Office Action of December 29, 2003.

STATEMENT OF THE FACTS

1. On July 25, 2001, the application was filed in the USPTO, as a national entry of PCT application No. PCT/JP99/01676 filed on March 31, 1999, along with original claims 1-21, Information Disclosure Statement (IDS) and an International Search Report (Form PCT/ISA/210) listing several references considered to be relevant under category "X" and category "Y", including: (1) JP 1-109249, A (Kurt Sauerwein); (2) JP 63-225153, A (Omron Tateishi Electronics Co.); (3) JP 5-107202, A (Hitachi, Ltd.); (4) JP 8-2601, Y2 (Meidensha Corp.); (5) JP 10-300688, A (Fujimori Kogyo Co., Ltd); (6) JP 6-118062, A (Toshiba Corp.); and (7) JP 4-12258, A (Marktec Corp.).

2. On October 29, 2002, a first Office Action (Paper No. 3) was issued in which the Examiner rejected allegedly claims 1-42 under 35 U.S.C. §112 for reasons that,

"[W]hole presentation is unclear. There are numerous independent claims which appear to be drawn to separate inventions. Prove unity or make selection. Claims appear to be couched in non-structural forms of desired results. Read each claim term by term on the drawing."

In addition, the Examiner also rejected allegedly claims 1-42 under 35 U.S.C. §102/103 for reasons that,

"As understood, claims appear to be essentially taught under 35 U.S.C. §102/013 by numerous 'X' and 'Y' references as discussed in the PCT. Compare claims to these references, filed an IDS indicating a U.S. Search and with English language equivalents or foreign references cited on the PCT."

3. On January 29, 2003, an Amendment was filed in which Applicants explained to the Examiner that the Office Action (Paper No. 3) is incomplete and fails to comply with 37 C.F.R. §1.104, and that all pending claims in the application are claims 1-21, and **not** claims 1-42 as incorrectly indicated in the Office Action (Paper No. 3). However, for purposes of expedition, Applicants canceled claims 1-21 without prejudice or disclaimer, and replaced the canceled claims 1-21 with new claims 22-42 to avoid potential §112 issues. More importantly, Applicants requested clarification from the Examiner as to which references under category "X" and "Y" in the PCT application are being used to support the rejections, if any, under 35 U.S.C. §102/103, since none of these references was ever cited to support any rejection as required under 37 C.F.R. §1.104.

4. On April 24, 2003, a first non-final Office Action (an unnumbered paper) was issued in which the Examiner ignored Applicants' request for clarification, but correctly identified pending claims 22-42. The Examiner again stated that,

"Claims 22-42 are subject tp [sic] the same rejections as set forth previously. As part of applicants' disclosure requirement it is necessary to point out the invention in view of the prior art which in this instance is the art cited and applied in detail in the PCT to claims of essentially the same subject matter and scope as 22-42. Also the independent claims appear to be drawn to different inventions, to be responsive, each independent claim must be argued as to unity of invention and the novel/unobvious language in view of Ssauverwein (which has a five page U.S. equivalent) and other IDS references pointed out."

5. On August 25, 2003, another Amendment was filed in which Applicants once again explained to the Examiner how the Office Action (Paper No. 3) is incomplete and fails to comply with 37 C.F.R. §1.104 and MPEP §707. More

importantly, Applicants explained in detail as to how each of the claims 22-42 as pending in the application distinguishes over each of the references under category "X" and "Y" in the PCT application, even though none of these references was ever cited to support any rejection under 35 U.S.C. §102/103 as required under 37 C.F.R. §1.104.

6. On December 29, 2003, a second non-final Office Action (another unnumbered paper) was issued in which the Examiner once again completely ignored Applicants' request for clarification, and Applicants' detailed explanations as to how each of the claims 22-42 as pending in the application distinguishes over each of the references under category "X" and "Y" in the PCT application, even though none of these references was ever cited to support any rejection under 35 U.S.C. §102/103 as required under 37 C.F.R. §1.104. Instead, the Examiner, once again, incorrectly identified the claims as pending in the application, that is, claims 1-28, as opposed to the actual claims 22-42 as pending in the application. In addition, the Examiner repeated the same incoherent response as set forth in the previously Office Action, and further stated that,

"New Claims 29-xx

New Claims 20-xx added by this amendment are dependent claims depending upon pending claims.

Conclusion

It is submitted that the added claims are supported by the application as filed and added no new matter.

This statement is not understood and should be clarified or canceled. And a proper response filed."

RELIEF REQUESTED

Based solely on the facts presented above, the Examiner's actions in all three Office Actions, including the first Office Action (Paper No. 3) dated on October 29, 2002, the first non-final Office Action (an numbered paper) dated on April 24, 2003, and the second non-final Office Action (another unnumbered paper) dated on December 29, 2003, have **not** be exemplary of what is expected from an United States Primary Patent Examiner, and what the United States Patent & Trademark Office (USPTO) is supposed to represent on behalf of inventors.

The Examiner's statements as presented in all three Office Actions, including the first Office Action (Paper No. 3) dated on October 29, 2002, the first non-final Office Action (an numbered paper) dated on April 24, 2003, and the second non-final Office Action (another unnumbered paper) dated on December 29, 2003, do **not** constitute any types of rejections of Applicants' pending claims 22-42 under either 35 U.S.C. §102 or 35 U.S.C. §103 as mandated by 37 C.F.R. §1.104 and MPEP §707. In particular, the Office Action (another unnumbered paper) of December 29, 2003, is utterly incomplete for reasons presented above.

More importantly, the latest statements from the Examiner as presented in the second non-final Office Action (another unnumbered paper) dated on December 29, 2003 are particularly disturbing, since claims 1-28 under rejection as identified by the Examiner are **not** the claims as pending in the application. Moreover, even if claims 1-28 are indeed pending in the application according to the Examiner's mindset, the Examiner's reference to "New Claims 29-xx" which is allegedly "added by this amendment" is completely baseless, particularly when no new claim has

been added in the Amended filed on August 25, 2003.

In any event, the burden of establishing a basis for denying patentability of Applicants' claims 22-42 under 35 U.S.C. §102 and 35 U.S.C. §103 rests upon the Examiner, and **not** with the Applicants. Applicants were **not**, and are **not** obligated under 37 C.F.R. and MPEP to explain and point out to the Examiner as to why claims 22-42 are patentable under 35 U.S.C. §102 and 35 U.S.C. §103, particularly, when no art has been cited or specified by the Examiner, and the Examiner has not provided any explanation as to how each feature of Applicants' claims 22-42 is anticipated under 35 U.S.C. §102 or rendered obvious under 35 U.S.C. §103 by any of the prior art references, allegedly labeled as "X" and "Y" references as discussed in the PCT note. Even so, and in the spirit of expedition and cooperation, Applicants have explained in detail as to how each of the claims 22-42 as pending in the application distinguishes over each of the references under category "X" and "Y" in the PCT application.

Under 35 U.S.C. §102 or 35 U.S.C. §103, the Examiner bears the initial burden of establishing a *prima facie* case of anticipation or obviousness. Only if this burden is met does the burden of coming forward with rebuttal argument or evidence shift to the Applicants. Ex parte Levy, 17 USPQ2d 1461, 1462 (1990) expressly states:

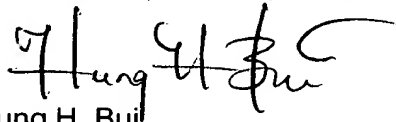
"it is incumbent upon the examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference."

In addition, 37 CFR §1.104(c)(4) requires the Examiner, when rejecting Applicants' claims 22-42 for want of novelty or for obviousness, must cite the best

references at his command. When a reference is complex or shows or describes inventions other than that claimed by the Applicants, the particular part relied upon must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

In the present situation, the Examiner has not formulated a complete Office Action, has not made any intelligent statement regarding the status of claims as pending in the application, has not explained how any of the "X" and "Y" references listed in the PCT sheet, including: (1) JP 1-109249, A (Kurt Sauerwein); (2) JP 63-225153, A (Omron Tateishi Electronics Co.); (3) JP 5-107202, A (Hitachi, Ltd.); (4) JP 8-2601, Y2 (Meidensha Corp.); (5) JP 10-300688, A (Fujimori Kogyo Co., Ltd); (6) JP 6-118062, A (Toshiba Corp.); and (7) JP 4-12258, A (Marktec Corp.), teaches each and every elements or at least renders those elements as defined in Applicants' claims 22-42 unpatentable and, more importantly, has not responded to Applicants' detailed explanations as to how each of the claims 22-42 as pending in the application distinguishes over each of the references under category "X" and "Y" in the PCT application. As a result, Applicants, pursuant to 37 CFR 1.181 and MPEP 710.06, respectfully petition that a complete Office Action with a substantive examination of the previously presented claims 22-42 be issued, and that the period for response be restarted.

Respectfully submitted,
ANTONELLI, TERRY, STOUT & KRAUS, LLP


Hung H. Bui
Registration No. 40,415

(703) 312-6600